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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Jae Keol Rhee, *et al.*
App. No	:	10/596,412
Pat. No.	:	7,816,379
Filed	:	June 13, 2006
For	:	NOVEL OXAZOLIDINONE DERIVATIVES
Examiner	:	Patricia L. Morris
Art Unit	:	1625
Conf No.	:	6355

REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) AND 35 U.S.C. § 154(b)(3)(B)(ii)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants submit this Request for Reconsideration of the Patent Term Adjustment (PTA) in accordance with **37 C.F.R. § 1.705(b)** and **35 U.S.C. § 154(b)(3)(B)(ii)** to correct the PTA calculation of 392 days for "**B delays,**" by the United States Patent and Trademark Office (hereinafter the "Office") to 493 days for B delays for a **total patent term adjustment of 1163 days.**

U.S. Patent No. 7,816,379 issued on October 19, 2010. This Request for Reconsideration is timely filed. A Request for Reconsideration under 37 C.F.R. § 1.705 was timely filed on January 12, 2010 for reconsideration of the appropriate "A" delays and a Request for Reconsideration to invoke the Supervisory Authority of the Director under 37 CFR § 1.181(a)(3) was filed on October 6, 2010.

The present PTA application is directed to the Office's errors in calculating B delay. The PTO's PTA calculation improperly excluded the time from when the Notice of Appeal was filed on September 14, 2009 to the time the Notice of Allowance was issued on December 24, 2009. However, as explained below, and as discussed with members of the PTO, the filing of the

Notice of Appeal should not be excluded from the normal B time PTA period in the present situation. As explained below, and as acknowledged by the PTO, this filing was an attempt by the Applicants to avoid prosecution delay and was only required in light of the PTO's erroneous and improper actions, which placed Applicants in a position where such a filing was needed to ensure that prosecution continued to move forward without further delay. As explained below, as the filing was withdrawn (and all of the PTO actions leading up to this filing were vacated) as improper, Applicants respectfully submit that Applicants should not be penalized for what was purely a PTO caused delay. Applicants note that the PTO has acknowledged this error, withdrawn and vacated the PTO correspondence leading up to and including the appeal itself, and provided Applicants with a full refund of the filing of the Notice of Appeal. Thus, the PTO's position on this set of filings is abundantly clear from the record. For at least the reasons outlined below, the date that the Notice of Appeal was filed should not be used to stop the clock of Applicants' B time.

The $200 fee set forth in 37 CFR 1.18(e) is provided herewith, in accordance with 37 C.F.R. § 1.705(b)(1).

In accordance with 37 C.F.R. § 1.705(b)(2), the statements of facts are as follows:

1. In accordance with 37 C.F.R. § 1.705(b)(2)(i), Applicants submit that the correct PTA for "B delays" from the day after three years from the filing date of June 13, 2006 to the issuance on October 18, 2010 is **493 days**. Applicants are entitled to PTA for B delays of 493 days due to Office delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b).[1]

2. In accordance with 37 C.F.R. § 1.705(b)(2)(ii), Applicants provide below the relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f), to which the patent is entitled.

    a. The Office's PTA determination listed on the Patent Term Adjustment History on PAIR does not properly account for all days of PTA under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b). Applicants submit that they are entitled to **493 days** of PTA under **35 U.S.C. § 154(b)(1)(B)** and **37 C.F.R. §§ 1.702(b)** and **1.703(b)** ("B delay").

        i. Applicants are entitled to a 493-day patent term adjustment due to the Office's 493-day delay for failure to issue a patent within three years of the actual filing date of the application as provided in 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b). Specifically, the application was filed June 13, 2006 and issued on October 18, 2010. The time period from the day after June 13, 2006 to October 18,

[1] Applicants do not acquiesce to the propriety of using the national phase filing date to calculate the B delay, but recognize that the Petitions Office may be bound to follow the 37 C.F.R. § 1.703(b)(4) that indicates that the national phase filing date is the date used to calculate the "B delay."

2010 is three years plus 493 days. Thus, the Office delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b) was 493 days.

ii. The Patent Term Adjustment History on PAIR appears to reflect a deduction of time from the filing of a Notice of Appeal on September 14, 2009 to the Notice of Allowance dated December 24, 2009. It appears that a subpart of the time was excluded under 37 C.F.R. §§ 1.702(b)(4) and/or 1.703(b)(4). However, the Notice of Appeal was vacated and a refund was issued on December 29, 2009 in light of errors made on the part of the PTO.

In the eight-page Petition Decision decided on October 8, 2009, signed by Director Yucel, the Director acknowledged "the extensive delays in initiating prosecution on the merits in this application" (page 7). In addition, it is undisputed that the Director stated "should there be any questions about this decision, please contact Quality Assurance Specialist Julie Burke, in a letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-0512...."

Applicants note that for the exception for B time under 37 C.F.R. §1.703(b)(4) to apply, "a notice of appeal to the Board of Patent Appeals and Interferences [must be] filed *under 35 U.S.C. 134 and § 41.31*." (Emphasis added). However, as outlined above, in the present situation, no filing under 35 U.S.C. §134 had been made in the eyes of the PTO, as the claims must have "been twice rejected" in order to make a filing under 35 U.S.C. §134.

In a telephone conference on December 7, 2010, Steven Brantley preliminarily agreed that the time period between the filing of the Notice of Appeal and the issuance of the Notice of Allowance should not be deducted from B delay, although he indicated that his opinion would be subject to review.

In light of the above, Applicants submit that the Notice of Appeal should not be considered as "filed" for the calculation of B delay. As such, the time for B delay should be defined as the time starting after 3 years from the filing date through to the issuance of the case.

3. In accordance with 37 C.F.R. § 1.705(b)(2)(iii), the present patent is not subject to a terminal disclaimer.

4. In accordance with 37 C.F.R. § 1.705(b)(2)(iv), there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R

§ 1.704 ("applicant delay"), as outlined in the Request for Reconsideration filed January 12, 2010 and the Request for Reconsideration filed October 6, 2010.

The proper PTA is the sum of non-overlapping "prosecution delays" before the Issue Fee was paid, "A delays" from the time the Issue Fee was paid until Issuance, and "B delays," minus any debit days for "applicant delay" under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R § 1.704. This calculation is described below and also illustrated in a chart below. In accordance with the Request for Reconsideration filed January 12, 2010 and the second Request for Reconsideration filed October 6, 2010, Applicants have previously asserted that they are entitled to a PTA of 864 days under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. §§ 1.702(a) and 1.703(a) until the date of the Notice of Allowance. The PTO calculated 106 days of additional "A delay" from four months from the date the Issue Fee was paid (July 5, 2010) until Issuance on October 19, 2010. The overlapping "prosecution delay" and "B delay" are from June 14, 2009 to December 24, 2009, or 194 days, plus the overlapping "A delay" and "B delay" from July 5, 2010 to October 19, 2010, or 106 days, for a total of 300 days. Applicants have previously stated that there was no reduction of days for "applicant delay" under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R § 1.704. Thus, Applicants submit they are entitled to the sum of 864 days of "prosecution delay" as of the mailing date of the Notice of Allowance plus 106 days of "A delay" plus 493 days of "B delay" minus 300 overlapping days and minus 0 days of "applicant delay," for a **total patent term adjustment of 1163 days**. This summary is represented in chart form below. The Applicants' PTA calculation is as follows:

Actions Under 35 U.S.C. § 154(b)(1)(A)		**Delays**		
Initial	**Responsive**	**PTO**	**Applicants**	**Overlap**
June 13, 2006 Filing Date	December 24, 2009 Notice of Allowance Issued	864 "prosecution delay"		
March 5, 2010 Issue Fee Payment Date	October 19, 2010 Patent Issued	106 "A delay"		106
Actions Under 35 U.S.C. § 154(b)(1)(B)		**PTO**	**Applicants**	**Overlap**
June 13, 2006 Filing Date June 13, 2009 (3 years from Filing Date)	October 19, 2010 Patent Issued	493 "B delay"		194

Actions Under 35 U.S.C. § 154(b)(1)(A) and (B)			**Delay & Overlap**		
Totals		**PTO Delays**	1463		
		Applicant Delays		0	
		Period of Overlap			300
		Patent Term Adjustment	**1163**		

Applicants hereby request the PTO to correct the calculation of PTA to reflect 1163 days.

Applicants note that the above PTA calculation is also consistent to what would have happened had the Examiner not withdrawn the case from Appeal. In particular, assuming everything else stayed the same and the case proceeded to appeal and was then allowed (as would have been the case, given the fact that the case was allowed by the PTO, the Applicants would have been entitled to the time between the filing of the appeal through to the Notice of Allowance (as "C" time). The only reason the above time period did not count as a delay on the part of the PTO was due an unusual circumstance that is not clearly accounted for in the rules. Applicants respectfully submit that as the rules do not take into account this situation, that the clear intent of the rules be given effect and that the Applicants be awarded the full amount of PTA noted above.

Applicants note that to penalize the Applicants for the time period between the filing of the Notice of Appeal and the issuance of the Notice of Allowance is clearly counter to the purposes of 35 U.S.C. §154(b) and that such a penalty improperly penalizes the Applicants for the PTO's delay. Applicants note that the ability to move prosecution forward was clearly, and solely, in the PTO's hands once the Notice of Appeal was filed. As such, any delay at this point was purely because of the PTO, and not due to any inaction or delay on the part of the Applicant. Furthermore, the filing itself was only required because of errors made by the PTO (as shown by the PTO subsequently vacating the actions). Furthermore, as noted above, if the case had been allowed to proceed, Applicants would have recovered the time under the "C" option. Only because the PTO withdrew the case from appeal (and all of the previous Office Actions), did the C time become unavailable. To penalize the Applicants under this scenario is clearly against the goal of the system, as the Applicants were trying to move this application forward, and only the inability of the PTO to provide a single actual Office Action, prevented the rapid allowance of this application. It is noted that to apply the rules as outlined by the PTO defies reason. For example, this situation would allow an Examiner to effectively remove any option of C time, simply by allowing the case after it had been appealed. Moreover, if the Applicants had not had an opportunity to file an appeal brief, they would have recovered no A time either, even if the case was immediately allowed the by PTO. Applicants note that, in such a situation, it is clear that any delay in the issuance is the fault of the PTO, as there is no opportunity for the Applicants to amend the claims, and as the PTO already had at least two opportunities to put forth all of the reasons for a rejection. Furthermore, the time of delay would clearly be at least the amount of time between the filing of the Notice of Appeal and the subsequent Notice of Allowance.

Applicants note that the above analysis can also be summarized in terms of providing the Applicants with the amount of time between 14 months after the national phase filing date until 3 years after the filing date, and then from the 3 year date until issuance (the three year date was selected so as to avoid any overlap of A and B time). This period comports with the lack of ***any*** valid Action under 35 U.S.C. §132 issued in this case. Per 1.703(a), if no actual action under 35 U.S.C. §132 is provided to the Applicant, then the PTA runs until the notice of allowance under 35 U.S.C. §151. As such, Applicants note that the Applicants' petition is consistent with the entirety of 35 U.S.C. §154b as well as the intent of the statute and the comments made by the PTO during prosecution. In contrast, the PTO's interpretation is inconsistent with 37 C.F.R. §1.703(1) (as not a single action issued in this case), inconsistent with the statements of record made by the Office, and inconsistent with the intent of the statute. Finally, Applicants note that

the record of this case clearly indicates that the PTO itself ***acknowledged and apologized*** for the delays caused by their actions. Applicants have reasonably relied upon these written statements, in the record, as adequate to demonstrate that the period between the Notice of Appeal and the issuance of the Notice of Allowance should not count against the Applicants. For the PTO to hold otherwise now would be inconsistent and arbitrary with respect to previous statements made, in writing and by the PTO, assuring the Applicants that Applicants would not be penalized for the PTO's errors.

As the PTO is aware, PTA was created to offset PTO delay in prosecution after the change in patent term to 20 years from filing (offset by any applicant delay, of course). The prosecution in this application was replete with errors and delays to such an extent that the PTO officially noted these delays (and memorialized them in an Interview Summary) stating that "[t]he Office regrets the delays and inconveniences which occurred during prosecution of this application...." For these reasons, the 1163-day adjustment is equitable and in line with the situation that was acknowledged by the Examiners prosecuting and reviewing the case as well.

The requested adjustment of 1163 days is respectfully requested.

If a decision in favor of the Applicants is rendered in response to the Request for Reconsideration to invoke the Supervisory Authority of the Director under 37 CFR § 1.181(a)(3), was filed on October 6, 2010, and results 1163 days of PTA, the present Request may be withdrawn.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 11-1410.

Respectfully submitted,

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Dated: December 20, 2010

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